

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL A. BAHR

Appeal No. 2001-0610
Application No. 08/931,932

ON BRIEF

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10, 12, 13 and 15-18. Claim 11 has been canceled, and claim 14 has been objected to.

We REVERSE.

BACKGROUND

The appellant's invention relates to a torque limited applicator, that is, a device for applying a limited amount of torque to a fastener. An understanding of the invention can be

derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Ohlson	3,425,314	Feb. 4, 1969
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Claims 3-10, 16 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 12, 15, 16 and 17 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Ohlson.

Claims 2 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohlson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 7) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 6) and Reply Brief (Paper No. 8) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

According to the appellant, this invention is useful in circumstances where it is desirable to have a torque limited applicator that is not attached to the fastener to which the torque is applied, but is reusable with a plurality of fasteners. An example of such a use is in the medical industry, where it is desirable to utilize devices that are of low enough cost that they are disposable. In furtherance of this aim, independent apparatus claims 1 and 17 are directed to a torque limited applicator having a torque applying element comprising a handle and at least two internal deformable cam followers, and a fastener drive structure comprising a cam at one end and a fastener drive structure at the other end. Independent method claim 16 sets forth steps which include the structure recited in the apparatus claims, and includes the step of completing the preceding steps a second time utilizing the same torque limited applicator with a different fastener.

The Rejection Under The Second Paragraph Of Section 112

The examiner has raised three issues under 35 U.S.C. § 112, second paragraph, which requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity; in making this determination, the definiteness of the

language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.¹

The first issue is that claim 3 is indefinite because the “clearance” as recited is not described and shown in the specification and the drawings, and therefore its location “is not understood.” Claim 3 recites the clearance as being

between said cam element and said contoured surface free ends so that said free ends may move between said cam element and said tubular body interior along substantially 360°.

This is exactly the manner in which this clearance is described in the specification in lines 14-18 of page 3. The appellant has argued in the Brief that the claimed clearance is illustrated in the drawings, and such appears to us to be the case. We therefore find ourselves in agreement with the appellant that claim 3 is not indefinite for the reason set out by the examiner.

The examiner also finds claim 16 to be indefinite, on two grounds. The first is that the terms “tactile” and “audible” are not equivalents “as each would require entirely differing structure” (Answer, page 2). Be that as it may, applying the guidance provided by our reviewing court for evaluating the compliance of a claim with the second paragraph of Section 112, we conclude that one of ordinary skill in the art would have no difficulty

¹In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

determining the metes and bounds of this claim, notwithstanding the presence of the language to which the examiner refers, and therefore the disputed language does not render the claim indefinite.

The examiner also is of the view that claim 16 is indefinite because the preamble states that the invention is directed to securing “a” fastener, which is singular, while step (e) states that the steps of the method are repeated, which indicates that the method is directed to a plurality of fasteners. We agree with the appellant that the method refers to securing one fastener at a time, and thus there is no inconsistency between the preamble and step (e), and the claim is not indefinite.

The rejection of claims 3-10, 16 and 18 under 35 U.S.C. § 112 is not sustained.

The Rejection Under Section 102

Claims 1, 12, 15, 16 and 17 stand rejected as being anticipated by Ohlson. Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention.² We cannot agree with the examiner that this is the case with any of the claims so rejected, and therefore we will not sustain this rejection.

²See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Independent claim 1 is directed to a “torque limited applicator,” which the appellant has disclosed as being a tool for applying a desired amount of torque to a separate fastener, such as a nut (Abstract; specification, pages 1-3, 12 and 13). As the appellant has correctly pointed out, the Ohlson invention differs from the invention recited in the preamble of claim 1 in that it is not an applicator for limiting the torque that can be applied to a fastener, but a fastener incorporating means for limiting the torque that can be applied to it. Thus, it differs conceptually from the claimed invention.

Moreover, the subject matter recited in independent claim 1 does not read on the Ohlson device. The appellant’s claim 1 recites a torque applying element having a tubular body and a handle, with the tubular body comprising at least two internal deformable followers. The examiner has considered the nut driver member 5 of Ohlson to be the claimed torque applying element, and we agree that this element has the tubular body and deformable cam followers required by the claim. However, the appellant urges that the Ohlson device is anticipatory because it is not provided with a handle (Brief, page 8), to which the examiner has offered no rebuttal, and so this argument stands uncontroverted. In the absence of persuasive argument by the examiner on this point, we are constrained to agree with the appellant that Ohlson lacks this claimed feature. In this regard, we note that while Ohlson instructs the artisan that the nut member is first finger tightened, which could be accomplished by grasping the flat surfaces 17 of nut driver member, the reference

further teaches that the tightening torque is applied by means of a wrench, not shown, which is placed on surfaces 17 of the nut driver member (column 2, line 52 et seq.). Thus, the wrench, which is not attached to the nut driver member, serves as the “handle” to apply the torque.

Finally, claim 1 also requires a fastener drive structure having a drive element adjacent one end and a cam element adjacent the other end. Ohlson discloses a “nut member” 3 that has a cam in the form of ratchet teeth 11 adjacent one end and an internally threaded fastener portion adjacent the other end, the latter to be tightened “on a complementary threaded bolt or stud” (column 1, lines 31 and 32). The examiner attempts to construe the construction of Ohlson’s nut member to meet these terms of the claim, apparently by reading “drive element” on the portion of the nut member that attaches the cam and the threaded fastener portion together, although this has not been explained in detail (see Answer, page 3). It is our opinion that this is not a tenable position, even if the claim language is considered in the abstract rather than in the context of the appellant’s disclosure, if for no other reason than it requires the one-piece nut member 5 to be artificially divided into separate elements, that is, the fastener portion to be considered to be apart from the rest of the nut member, which flies in the face of the concept of the Ohlson invention. The fact of the matter is that in the Ohlson system it is the fastener being

torqued that carries the cam, whereas in the invention recited in claim 3 the cam is part of a fastener drive structure while the fastener is not.

For these reasons we will not sustain the Section 102 rejection of claim 1.

The same structure is required in independent claim 17, and we thus will not sustain the like rejection of that claim.

Independent claim 16 is directed to a method of securing a fastener in place. In the context of its steps, it recites the same structure as is present in claims 1 and 17, and therefore the anticipation rejection fails for the same reasons. In addition, the final step of claim 16 is to repeat the four preceding steps with a second fastener using the same torque limited applicator. While the system disclosed by Ohlson might be capable of use with a second nut member, such a method is not disclosed therein, and the reference fails to anticipate the claim on this ground.

The Rejection Under Section 103

This rejection is applied to dependent claims 2 and 13, both of which depend from claim 1 and therefore include all of the structure recited in claim 1. We have considered Ohlson anew in the light of 35 U.S.C. § 103(a).³ However, from our perspective, one of ordinary skill in the art would not have been motivated to modify Ohlson in such a fashion

³The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

as to overcome the deficiencies noted in our discussion of the rejection of claim 1 under 35 U.S.C. § 102(b), for to do so would require a wholesale reconstruction of the Ohlson system and would destroy Ohlson's invention, and that would be a disincentive for the artisan to undertake. Moreover, the only suggestion for doing so is found in the hindsight afforded one who first viewed the appellant's disclosure, which is an impermissible basis for a rejection under Section 103.⁴

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LAWRENCE J. STAAB)	
Administrative Patent Judge)	

⁴In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

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